

REMARKS

In the Office Action, the Examiner rejected claims 1-8, 10-25, and 68-110. Applicant canceled claims 9 and 26-67 in a previous communication. By the present Response, Applicant cancels claim 73 without prejudice. For the reasons set forth below, Applicant respectfully submits that all of pending claims 1-8, 10-25, 68-72, and 74-110 are allowable in their present form. Accordingly, Applicant respectfully requests reconsideration of the above-referenced application in view of the following remarks.

Rejections Under 35 U.S.C. § 112

In the Office Action, the Examiner rejected claims 1-8, 10-25, 68-72, and 74-110 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Specifically, the Examiner contended that:

Taken as a whole the claims recite an undue multiplicity of claims by virtue of the unreasonable number of claims presented would tend to obfuscate, confuse, and becloud the claimed invention. Because the examiner believes that in his judgment that twenty (20) claims are sufficient to properly define applicants' invention, applicants are required to select certain claims, not to exceed twenty for examination on the merits of which no more than six are independent claims, See M.P.E.P. 2173.05(n). To be complete the non-selected claims must be cancelled or the applicant(s) must present appropriate arguments as to why the above rejection is in error. Note also the new excess claim fees effective 12/8/04 as evidence of what is considered to be unreasonable.

It is further noted that it would appear that a multiplicity of inventions also appear to be involved and the applicants are requested to group their selection accordingly to read on a single invention that was examined in the last office action. The applicant should group the claims according to what he believes to be distinct inventions that may be restricted in a subsequent action.

Office Action mailed October 27, 2005, pages 2-3 (emphasis omitted). Applicant vigorously traverses this rejection.

As an initial matter, all of the claims of the present application are drawn to a method for analyzing a capital investment in medical resources for a medical facility and are properly associated with Group I as set forth by the Examiner in a previous communication. See Office Action mailed November 23, 2004, page 2. Further, in response to the present rejection, Applicant preliminarily selects claims 1, 4-8, 10-14, 20-25, 68, 84, and 90 for examination on the merits. However, as discussed below, Applicant strongly believes that the present rejection was made in error and is wholly untenable. As such, Applicant respectfully requests withdrawal of the present rejection and examination of all pending claims. Further, should the Examiner fail to remove the present rejection, Applicant respectfully requests an interview with the Examiner's supervisor to discuss the improper rejection.

As the Examiner will appreciate, long-established legal precedent clearly sets forth that:

[A]pplicants should be allowed reasonable latitude in stating their claims in regard to number and phraseology employed. The right of applicants to freedom of choice in selecting phraseology which truly points out and defines their inventions should not be abridged. Such latitude, however, should not be extended to sanction that degree of repetition and multiplicity which beclouds definition in a maze of confusion.

In re Chandler, 138 U.S.P.Q. 138, 148 (C.C.P.A. 1963); see also, e.g., *In re Flint*, 162 U.S.P.Q. 228, 231 (C.C.P.A. 1969) (stating "The [42] claims differed from one another and we have no difficulty in understanding the scope of protection. Nor is it clear, on this record, that the examiner or board was confused by the presentation of claims in this case or that the public will be."); *In re Wakefield*, 164 U.S.P.Q. 636, 639 (C.C.P.A. 1970) (stating "Examination of forty claims in a single application may be tedious work, but this is no reason for saying that the invention is obscured by the large number of claims.").

Applicants respectfully note that the presently pending claims include four independent claims, namely claims 1, 68, 84, and 90. It is readily apparent that these

claims vary in scope from one another. Particularly, claims 1, 68, and 84 each contain unique recited elements that are absent from each other. For instance, independent claim 1, as amended in the previous Response, recites “financial data including an internal discount rate set by the client for evaluating investment acceptability.” Independent claims 68 and 84 do not include this subject matter. Independent claim 68 recites “financial data including client-defined potential financing terms for the potential capital investment.” Independent claims 1 and 84 do not include this subject matter. Independent claim 84 recites “the client data comprises financial data relating to ... medical procedure statistics expected to be changed by implementing the desired capital investment.” Independent claims 1 and 68 do not include this subject matter. Additionally, independent claim 90 recites all three of these recitations and is clearly of a different scope than independent claims 1, 68, and 84. The claims depending from these independent claims also introduce additional subject matter of various scope.

As noted by the Examiner, the Patent Office has established fees for any claims submitted by an applicant in excess of three independent claims and twenty dependent claims, presumably to defray the costs associated with the additional time and effort expended by examiners in examining the extra claims. In the present case, Applicant has submitted additional claims *and has paid the necessary fees for these claims*. As a result, Applicant has a reasonable expectation that these additional claims will be given a fair and just examination on the merits.

With the utmost respect, Applicant again directs the Examiner’s attention to the court decisions in *Flint* and *Wakefield*, and particularly to the quotes reproduced above, which clearly suggest that the mere fact that examination of additional claims may be tedious is *not* a valid excuse for asserting that an invention is obscured by the large number of claims. Further, in this present instance, the Examiner has not provided even a scintilla of evidence in support of his assertion that the presentation of the claims are somehow confusing to the Examiner, or would be confusing to one skilled in the art. If

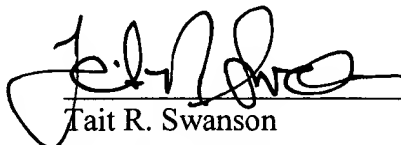
the Examiner truly believes such to be the case, Applicant would be happy to assist the Examiner in understanding the present claims, or to discuss why one skilled in the art would not be confused by the claims. Otherwise, Applicant respectfully requests that the Examiner withdraw this rejection of claims 1-8, 10-25, 68-72, and 74-110 under 35 U.S.C. § 112.

Conclusion

In view of the remarks set forth above, Applicant respectfully requests allowance of the pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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